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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,872	11/28/2001	Tsunehiro Tsukada	35.G2941	9796

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EXAMINER
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HANG, VU B

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/994,872

Applicant(s)

TSUKADA, TSUNEHIO

Examiner

Vu B. Hang

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/28/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Information Disclosure Statement***

The information disclosure statement filed 02/22/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the list of references for the application (PTO-1449) is missing. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C (1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 6,094,276) in view of Danknick et al. (US Patent 5,901,286).

Regarding **Claims 1, 6, 11, 16**, Yamaguchi discloses an information processing apparatus (see Fig.1) comprising: a generation unit adapted to

Art Unit: 2622

generate print data (see Fig.2 and Col.3, Line 1-14) and a transmission control unit adapted to control transmission so that the print data generated by the generation unit is transmitted to a print server (see Fig.1 and Fig.5 (550) and Col.4, Line 13-29). Yamaguchi, however, fails to expressly disclose that the generation unit is adapted to generate print data in response to a request and screen displayed from an external apparatus. Danknick discloses that data files can be generated and transmitted by an external apparatus over the network to a server in a request /response manner (see Figs.4, 12 and Col.3, Line 58-61, Col.4, Line 4, Line 53-57).

Yamaguchi and Danknick are combinable because they are from the same field of endeavor, namely information processing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to include a generation unit to generate print data in response to a request and screen displayed by an external apparatus to the information apparatus with a transmission control unit. The benefit of doing so would be to create a network information processing apparatus that would allow multiple information processing for multiple users within the network. It is obvious that the apparatus described above would allow a more efficient form of information processing in a network environment.

Regarding **Claims 3, 8, 13, 18**, Yamaguchi and Danknick disclose the information processing apparatus as described in Claim 1 above but Yamaguchi fails to expressly disclose that the screen displayed from the external apparatus is in the form of a web browser and that the request from the external apparatus

Art Unit: 2622

is communicated between the web browser and a web server on the information processing apparatus. Danknick, however, further discloses that the screen displayed by the external apparatus is in the form of a web browser (see Fig.12 and Col.2, Line 1-4) and that the request from the external apparatus is communicated between the browser and a web server (see Fig.4 and Col.2, Line 1-9).

Yamaguchi and Danknick are combinable because they are from the same field of endeavor, namely information processing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to use a web browser as a display screen for the external apparatus and the use of the web server for communicating requests from the external apparatus. It is known in the art that the use of a web browser is common when dealing with communicating requests over a network. It is also well known in the art that communication between an individual external apparatus and other devices in the network environment is typically done through a web server. Therefore, it is obvious to use a web browser as a client display screen and a web server for request communication over the network.

Regarding **Claims 4, 9, 14, 19**, Yamguchi and Danknick disclose the information processing apparatus as described in Claim 1 but Dancknick fails to expressly disclose a determination unit and a transmission control unit within the apparatus. Yamaguchi further discloses a determination unit adapted to determine when the print server can transmit data to a plurality of printers (see Fig.4 (790) and Col.4, Line 5-12) and a transmission control unit that controls the

Art Unit: 2622

transmission of print data to the designated printer determined by the determination unit (see Fig.4 (221) and Col.3, Line 60-64).

Yamaguchi and Dancknick are combinable because they are from the same field of endeavor, namely information processing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to include a determination unit a transmission control unit to the apparatus described in Claim 1. The determination unit is necessary in a network information processing apparatus since it functions as a job or transmission scheduler in the apparatus. A scheduler function is needed to manage the transmission of data when dealing with multiple printings in a network environment. It is also known in the art that a transmission control unit is usually embedded in a print server to control the transmission of data to the designated printers in a network environment.

Claims 2, 7, 12, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 6,094,276) in view of Danknick et al. (US Patent 5,901,286), and in further view of Edmunds (US Patent 6,006,281).

Regarding **Claims 2, 7, 12, 17**, Yamaguchi and Danknick discloses the information processing apparatus as described in Claim 1 above, but fail to expressly disclose a specification unit adapted to specify a template for generating print data and a generation unit that generates data based on the template and the data specified by the specification unit. Edmunds, however, discloses a specification unit that specifies a template for generating print data and inserting them into the template (see Fig.6 and Col.1, Line 5-11, Col.7, Line

Art Unit: 2622

10-13). Edmunds also discloses a generation unit that generates print data based on the template and data from the specification unit (see Fig.6 and Col.1, Line 5-11, Col.1, Line 59-64).

Yamaguchi, Danknick and Edmunds are combinable because they are from the same field of endeavor, namely information processing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to include in the apparatus described in Claim 1 a specification unit to specify a template for generating print data and a generation unit for generating the print data based on the template from the specification unit. The motivation for doing so would be to allow a network information apparatus with more flexibility in terms of printing print data. The use of a template and the generation of print data based on the template would eliminate the need of individual print data conversion functions within a network device (such as a server or printer) to meet the specific data format for the devices. This would in turn allow more efficient data conversions for printing since it would take less memory space and time to complete the print data conversion process in the network environment.

Claims 5, 10, 15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 6,094,276) in view of Danknick et al. (US Patent 5,901,286), and in further view of Levine et al. (US Patent 6,020,973).

Regarding **Claims 5, 10, 15, 20**, Yamaguchi and Danknick discloses the information processing apparatus as described in Claim 1 above. Danknick further discloses an obtaining unit adapted to obtain the status information on the

Art Unit: 2622

plurality of printers (see Col.1, Line 38-44). Yamaguchi and Danknick, however, fail to expressly disclose a selection control unit adapted to prohibit an unusable printer from being selected by the external apparatus. Levine discloses such selection control unit that can prohibit an unusable printer from being selected by an external apparatus (see Fig.5 (208) and Col.11, Line 1-8).

Yamaguchi, Dancknick and Levine are combinable because they are from the same field of endeavor, namely information processing apparatus. At the time of the invention, it would have been obvious for one skilled in the art to include an obtaining unit and a selection control unit to the apparatus described in Claim 1. It is well known in the art that a unit that can detect the status of individual printers is necessary in network printing environment. Most network printing apparatuses or information processing apparatuses usually place a high priority on efficient printing or information processing. Efficiency cannot be achieved without device status detection. It is also well known in the art that, based on the status information, an unusable device can be prohibited from selection by an external apparatus.

**Claims 21-25** recite identical features as Claims 1-5 except Claim 21-25 are in a form of a computer readable recording medium. Thus, arguments similar to that presented above for Claims 1-5 are equally applicable to Claim 21-25 because without a computer readable recording medium to store a program that makes it possible for the apparatus to operate, the apparatus described in Claims 1-5 could not function.



Art Unit: 2622

**Claims 26-30** recite identical features as Claims 1-5 except Claim 26-30 are in a form of a computer readable recording medium. Thus, arguments similar to that presented above for Claims 1-5 are equally applicable to Claim 26-30 because without a computer readable recording medium to store a program that makes it possible for the apparatus to operate, the apparatus described in Claims 1-5 could not function.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 26** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 26 is drawn to non-functional descriptive material. MPEP 2106.IV.B.1 (a) (Nonfunctional Descriptive Material) states:

“Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101.”

“Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.”

“For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the know compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional

Art Unit: 2622

descriptive material cannot alone provide the practical application for the manufacture.”

MPEP 2106.IV.B.1 (Nonstatutory Subject Matter) states:

“When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement”.

**Claim 26** currently recites “a computer program product”. There is no functional relationship imparted by this data to a computing device. Therefore, the claim is drawn to non-functional descriptive material, which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vu Hang  
Assistant Examiner

*Vu Hang*

08/16/2005

JOSEPH R. POKRZYWA  
PRIMARY EXAMINER  
ART UNIT 2622

*Joseph R Pokrywa*